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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,036	03/16/2004	Stephen D. Pacetti	050623.00311	7967

45159 7590 09/03/2010  
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EXAMINER
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HELM, CARALYNNE E

ART UNIT	PAPER NUMBER
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1615

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Continuation Sheet**

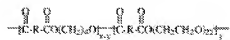
Continuation of Box 11:

Applicants dispute the argument that the instantly claimed copolymer is not a diblock copolymer. Specifically applicants state that "on page 23, lines 7-10 the structure of the block copolymers of the invention is clearly set forth:  $[M-P]_m-[M-Q]_n$ ." A copy of this segment referenced in the substitute specification is shown below:

As a result of the synthesis, biologically absorbable PEAs having a general formula (A) or poly(esters) having a general formula (B) can be obtained:



The depiction of formula A appears to be that to which Applicants refer; however, this formula contains additional bonds on both ends of the depicted copolymer that were omitted in Applicants' reply. The representation provided by the instant specification is also used by Bezemer et al. to represent multiblock copolymers



(see Scheme 2). Applicants do not describe their claimed polymers as diblock copolymers, nothing has been presented that indicates the invention only embraces diblock configurations, and prior art indicates that Applicants' chosen nomenclature has been used to describe multiblock copolymers. Therefore the interpretation of the claimed polymeric structure as a multiblock is not beyond the broadest reasonable interpretation of the claims.

In response to applicant's argument that Bezemer teaches diamine elements which are not taught by Katsarava et al., the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the

primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicants provide a series of assertions about the possibility of deriving the instant polymer from that of Katsarava et al. as well as brush aside the teachings highlighted in the prior art that would have motivated modification of Katsarava et al. and rendered obvious the instantly claimed invention. This collection of statements is unpersuasive regarding the obviousness of the instant invention in light of the cited prior art teachings. While applicants dispute the similarity of the synthesis scheme between the instant applicant and that of the prior art as well as correctly highlight the inadvertent description of the amines in Katsarava et al. and the instant application as diamines in a sentence of the Examiner's previous reply, this opposition does not outweigh the teachings of the prior art. Therefore the rejection of claims 1, 3-6, 13-15, 19-21, 23-27, 34-36, and 40-41 under 35 USC 103(a) over Katsarava et al. in view of Katsarava B, Nagata, and Bezemer et al. as well as the rejection of claims 1-2 and 21-22 under 35 USC 103(a) over Katsarava et al. in view of Katsarava B, Nagata, Bezemer et al., and Michal are maintained.